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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,106

08/24/2004

George J Nassef Jr

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03/20/2007

VALETNOIR INC - A NEW YORK CORPORATION

1140 BROADWAY

SUITE 903

NEW YORK, NY 10001

EXAMINER

BOND, CHRISTOPHER H

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/711,106

Applicant(s)

NASSEF, GEORGE J

Examiner

Christopher H. Bond

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/24/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,6-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. As to claim 1, it appears to be an apparatus claim, based on the preamble, having a database with gaming history thereon. However, the last line of the claim appears to be structured as a method limitation and raises some confusion if this is an intended use statement or an actual method limitation required in the claim—it is unclear of the applicant's intent.

4. As to claims 6-24, again, it is unclear as to the applicant's intent—that is to say, if these are apparatus or method claims. For example, claim 6, ("having said system connecting to other database systems"), claim 7, ("having said other database systems being used to form a trip"), claim 8 ("having said system contacting said casino client"), and so forth.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-24 are rejected under 35 U.S.C. 101 because 35 U.S.C. 101 allows a single statutory class of invention in a single claim.

6. As to claim 1, it appears to be an apparatus claim, based on the preamble, having a database with gaming history thereon. However, the last line of the claim appears to be structured as a method limitation. This claim appears to include both an article/machine along with a process positively claimed.

7. As to claims 6-24, again, it is unclear as to the applicant's intent—that is to say, if these are apparatus or method claims. For example, claim 6, ("having said system connecting to other database systems"), claim 7, ("having said other database systems being used to form a trip"), claim 8 ("having said system contacting said casino client"), and so forth. These claims appear to include both an article/machine along with a process positively claimed.

8. See M.P.E.P 2106, Section IV.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-13, 22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al., US PUB 2003/0003988 (Walker).

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11. As to claims 1-6, Walker discloses a method and apparatus for planning and customizing a gaming experience where (paragraph [0031]), "...a central controller communicates with multiple user devices , multiple casino servers, and multiple marketer devices. The casino servers, in turn, are in communication with multiple casino devices, including gaming devices... a user may log onto a Web site hosted by the central controller. On the Web site, the user may prepare for his vacation by inputting a preferred gaming device configuration, choosing a betting system, selecting a group of friends with which to share winnings, and by performing or using other aspects of the invention mentioned above. The central controller may then associate all the data defining the user's preparations with a preparation code or a user identifier, such as the user's name or a player tracking card number, and store the user's preparation data in, for example, a preparation database and the user identifier in a user database." He further discloses (paragraph [0087]) that, "...the central controller... may comprise one or more computers...that are connected to a remote server computer operative to maintain databases, where the data storage device...is comprised of the combination of the remote server computer and the associated databases." Walker further discloses (paragraph [0059]) that, "The term "player tracking card" may refer to a device that may be capable of storing information about a consumer who is a casino player. Walker further discloses (paragraph [0106]), "The user database...provides example data to illustrate the meaning of the information stored in this database embodiment. A player identifier...may be used to identify and index the players listed in the player database...examples of player information are provided: "Sam Brown" with

credit card number "1111-1111-1111-1111" is a "male, age 23" who played on gaming device "M234" and has a lifetime theoretical win of "2,345.00"... (This meets the applicant's limitation of having a self-service system for game player comprised of a database with data and historical data about a player, allows data to be accessed by a player, specifically through the web (Internet), where the databases can be from multiple casinos).

12. Accordingly, claims 1-6 would have been anticipated.

13. As to claim 7, Walker discloses (paragraph [0003]), "The present invention relates to methods and apparatus for planning and customizing a casino gaming and vacation experience. More specifically, the present invention relates to permitting a player, or others, to plan and customize activities and elements of playing at, and visiting a resort casino, according to the player's preferences and/or characteristics."

14. As to claims 8-10, Walker discloses (paragraph [0031]), "...a central controller communicates with multiple user devices..." Walker further discloses (paragraph [0154]), "The central controller...may search a database of gaming device statistics to find any that meet user criteria. If there are any such gaming devices...the central controller...may display information about them to the user." This is equivalent to the applicant's limitation of having a self-servicing system, that contacts a casino client, contacts a gaming player based on selection criteria where the selection information is contained in the database.

15. Accordingly, claims 8-10 would have been anticipated.

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16. As to claims 11 and 12, Walker discloses (paragraphs [0211] and [0220]) that, "...a user may input rules that will govern his actions at the casino...[and] [t]he gaming device may strictly enforce the user-defined rule by, for example, forcibly cashing out the user and ceasing to operate so long as the user's player tracking card is inserted. Alternatively, the user device may simply encourage the user to quit, reminding him that he had intended to quit at this point." This is equivalent to the applicant's limitations of having a system that compares data against a rule set (user's input rules), notify if a rule set is broken (inform user with encouraging reminder) and suspend if one or more of the results conflict (forcible cash out).

17. Accordingly, claims 11 and 12 would have been anticipated.

18. As to claim 13, Walker discloses (paragraph [0181]) that, "...the user may enter data describing a desirable machine interface. Aspects of the machine's interface may include...language..." Walker further discloses (paragraph [0100]), "...language selection [may be] (English, Spanish, German, Japanese, Chinese) [etc.]..." This is equivalent to the applicant's limitation of having a system that has a communication means for players and users to contact each other in their native languages.

19. As to claim 22, Walker discloses (paragraph [0161]) that, "A user may remotely input pictures of music. For example, the user may scan a picture of himself..." This meets the applicant's limitation of being able to upload a picture of himself in the database.

20. As to claim 24, Walker discloses (paragraph [0027]) that, "...a user may arrange to receive marketing offers at a casino." It is understood that casinos do this regularly to

maximize their profits and venue turnout and meets the applicant's limitation of having a self-servicing system further comprising having venues contacting casino clients with offers for their venues in order to maximize profit and venue turnout.

21. As to claim 18, Walker discloses (paragraph [0154]), "The central controller...may search a database of gaming device statistics to find any that meet user criteria." Its understood that this constitutes qualifying criteria and is equivalent to the applicant's limitation of a self-servicing system further comprising having said users searching based on qualifying criteria.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 14-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker.

24. What is disclosed in Walker is discussed above and incorporated herein.

25. As to claims 14-16, while Walker discloses that his invention can contact the casino client—i.e. the user—but he fails to explicitly disclose the means used to contact the user.

26. Walker discloses (paragraph [176]), "In some embodiments of this invention, the user may set up lines remotely using the Web site of the central controller. The user



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may input information... Such information may include a name, home address, telephone number, email address..." In an exemplary use of the invention, Walker further discloses (paragraph [0334]), "Sam began his planning by logging onto the Web site... He saw there were many aspects of his vacation for which he could plan. He set an account with the Web site by typing in his name, age, email address, and home address." It is well known that home address, telephone number, and email address are all pertinent, and particularly popular forms of contact information, so it would be very obvious to include these as the forms of notification from the self-servicing system.

27. Accordingly, claims 14-16 would have at least been obvious.

28. As to claim 17, While Walker discloses that the central controller communicates with a variety of databases including a Preparation database and a User database, he fails to explicitly disclose that other databases are Customer Management Systems of casinos.

29. Walker discloses (paragraph [0064]) that preparation data, which is stored on the preparation database, "...may refer to any data received from, or related to, a user that is descriptive of characteristics of the user's desires, aspirations, intentions, expectations, preferences, and/or plans related to his gambling experience or gambling vacation." Walker further discloses (paragraph [0265] and [0275]), "...a user may submit preparation data detailing the entertainment and convenience features he would like...what environmental conditions most suit him...the number of casino personnel available to serve a user...data that pertains to the user's preferred drink or drinks." All of this data is stored on the preparation database, and since it relates to the casinos'

customers, it would have been obvious that this could be used as or called a Customer Management System.

30. As to claim 19, while Walker discloses that the user can search and plan based on his criteria, he does not specifically disclose searching for a plurality of casino options based on their established validated play, likes and dislikes, next planned trip, favorite destinations, and other key items to interested persons.

31. One skilled in the art would recognize that a player tracking card commonly 'tracks' the games a user plays, as well as gaming history for the purpose of marketing, providing comps, etc. Walker has already discussed how a user can provide preferences—i.e., likes and dislikes—as part of their preparation data. It would have been obvious to one of ordinary skill in the art to include these limitations,, as they are common, and well known in the art.

32. As to claim 20, while Walker discloses that the casino can provide offers to a client, he does not specifically discloses that the offers are based upon their gaming history.

33. Again, it is notoriously well known in the art, that casinos base their offers and comps on a player's gaming history—more specifically, gambling duration, max. bet, type of machine, amount of money gambled, etc.

34. As to claim 21, while Walker discloses a database, capable of storing a players gaming history, vacation history, user data, etc., Walker does not specifically disclose that the user has the ability to hide or unhide certain parts of their personal attributes until they feel comfortable exposing this information to a new casino destination.

35. It is notoriously well known that databases are based on a query system, and the ability to hide/unhide information is purely a matter of design based on the database's designer. A commonplace example of this is an Internet forum, which often includes an applicant's screen name, location, number of posts on the forum, and email address. A user can often configure which data he wants displayed on which data he does not—i.e. 'hide email address'. It would have been obvious to include this option on the system.

36. As to claim 23, Walker discloses (paragraph [0114]) that, "...a gambling circle database...is used to track such things as gambling circle members' identity, contact information, and benefits, as well as to associate players with their gambling circle members. Note that a gambling circle may include any number of members." Walker however does not specifically disclose that his invention can be used invites members to join groups based on established play for the purpose of group travel.

37. Walker's invention is used for planning a customizing a game experience for one person, but it would have been obvious to one of ordinary skill in the art at the time of the invention was made to design this system to accommodate a group, instead of an individual person. It would have been an obvious matter of design choice to allow for a plurality of people, since such a modification would have involved a mere change in the number of people using the system to plan and customize a gambling experience. A change in the number of people using the invention is generally recognized as being within the level of ordinary skill in the art.

***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPAT 6,842,737 Stiles et al, as it relates to travel information system—planning and customizing; USPAT 7,063,618 Walker et al and US PUB 2003/0027635 as they both relate to determining casino offers and comps; USPAT 6,628,939 Paulsen, as it relates to a personal gaming device which can serve as an interface between hotel reservations systems, etc.; and US PUB 2004/0214622 Atkinson, as it relates to an information collection system for a game network that a player can customize.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Bond whose telephone number is (571)-272-9760. The examiner can normally be reached on 9:30am – 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Bond  
Examiner  
Art Unit: 3714

CHB

*Ronald Seneor*  
Primary Examiner  
3/19/07